

Remarks

Claims 1, 4-6, 8-11, 13-24, 49-72, 74, 76, and 77 are presented for the Examiner's review and consideration. Claims 9-17 are withdrawn. In this Response, claims 1, 6, 58, 59, 71, and 77 are amended and claim 75 is cancelled. Applicant believes the claim amendments and the accompanying remarks herein serve to clarify the present invention and are independent of patentability. No new matter has been added.

35 U.S.C. §102 Rejection

Claims 1, 4, 5, 18, 19, 24, 49, 53, 54, 58-60, 62-72, and 75-77 were rejected under 35 U.S.C. §102(b) as being anticipated by Egan *et al.* (U.S. 6,174,324, "Egan"). For reasons set forth below, Applicant respectfully submits that this rejection should be withdrawn.

Egan relates to a suture guide and fastener and has been discussed in prior Responses, and in the interest of brevity, these discussions are incorporated by reference herein, and the arguments pertaining thereto are hereby reasserted.

Although Egan discloses different embodiments, the embodiment of FIGS 10-12 is cited in the Office Action. This interpretation of Egan is summarized with the annotated FIG 11 of Egan presented in the Office Action and reproduced herein.

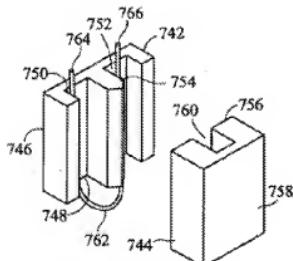
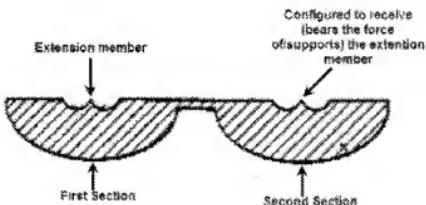


FIG. 30B

Even if this construction of Egan is accepted, which Applicant does not concede, Egan still does not teach or suggest the elements of the invention as set forth in claims 1, 71, and 77. Each of these independent claims is directed to a fastener and recites, among other things, that the fastener has a first section including a first surface and further including an extension member extending from said first surface, and a second section including a second

surface with a recess. The second surface opposes the first surface and is configured for receiving at least a portion of the extension member in the recess. The extension shortens in length when the first and second sections are bonded together or the extension shortens in the direction of force applying pressure to the fastener. This is shown, for example, in FIG. 30B, reproduced herein. With Egan, there is no recess into which at least a portion of an extension is received and there is also no shortening of this extension. Even though the Office Action references the embodiment of FIG 11, none of the other embodiments of Egan has both of these features.

Thus Egan does not suggest or teach all of the elements recited in claims 1, 71, and 77 of the instant invention. Accordingly, Applicant respectfully submits that claims 1, 71, and 77 are patentable over Egan. As claims 4, 5, 18, 19, 24, 49, 53, 54, 58-60, 62-70 depend from claim 1 and claim 76 depends from claim 71, these dependent claims necessarily include all the elements of their base claim. Accordingly, Applicant respectfully submits that the dependent claims are allowable over the cited references for at least the same reasons.

In light of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the §102 rejection.

35 U.S.C. §103 Rejection

Claims 6, 8, and 50-52 were rejected under 35 U.S.C. §103(a) as being unpatentable over Egan in view of Merritt (U.S. Patent No. 5,208,950, “Merritt”). Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over Egan in view of Hart (U.S. Patent No. 5,208,950, “Hart”). Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over Egan in view of Tokushige *et al.* (U.S. Patent No. 5,866,634, “Tokushige”). Claim 22 was rejected under 35 U.S.C. §103(a) as being unpatentable over Egan in view of Bartlett (U.S. Patent No. 5,879,372, “Bartlett”). Claims 23 and 74 were rejected under 35 U.S.C. §103(a) as being unpatentable over Egan in view of Rhee *et al.* (U.S. Patent No. 5,752,974, “Rhee”). Claims 55-57 and 61 were rejected under 35 U.S.C. §103(a) as being unpatentable over Egan.

For reasons set forth below, Applicant respectfully submits that these rejections should be withdrawn.

As an initial matter, it is noted that the references are described separately only to clarify the teachings of each reference. Thus, the presentation of references separately is not and should not be construed as an attempt to “argue references separately.” It is further noted that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). However, a simple teaching of elements is insufficient. In order to establish a proper *prima facie* case of obviousness, the prior art must also suggest the desirability of the claimed invention and/or give some reason for references to be combined. Therefore, in order to properly establish a *prima facie* case of obviousness, a rejection must not only show that all elements of the claimed invention are known or suggested in the prior art, but must also show that one of ordinary skill in the art would have some reason or motivation to put all the elements together to achieve the claimed invention.

Like Egan, the other cited references have been discussed in prior Responses, and in the interest of brevity, these discussions are incorporated by reference herein, and the arguments pertaining thereto are hereby reasserted.

Egan

Egan is as discussed above. Applicant further notes that as set forth above, Applicant agrees with the statement in the Office Action (page 11) that Egan discloses various embodiments. However, in all of these embodiments, there is melting of the suture strands. There is nothing to indicate that two different sections of the suture retaining device are bonded together. As stated in Egan (Col 5, lns 13-22):

According to an important aspect of the invention, the suture retaining device 102 can function as a stationary ultrasonic weld anvil and transmits vibrational energy to the suture strands within it, thereby effecting relative motion between the strands and causing localized melting of the strands so as to create a molecular bond or weld between the suture strands. Alternatively, if the suture retaining device is made of a material similar to that of the suture strands, application of energy to the suture retaining device can cause it to melt with the suture strands, thereby effecting a bond between the suture strands and the retaining device.

In Egan, the statement (Col 6, lns 19-22) that the fastener “becomes an integral structure of the bonded suture loop,” supports the position that the suture bonds to the fastener. Therefore,

with respect to claims 55-57, Egan would not have an object made of metal because melting of a metallic strand would require extremely high temperatures and Egan would not have an object made of body tissue because melting of body tissue could be problematic.

Merritt

Merritt discloses “A mechanical cord lock forming a non-slipping loop in an elastic cord such as elastic bungee cord employed in a vehicle restraining net. The connector includes two releasably engageable parts one of which has concave sidewalls formed on opposite sides thereof and a central wall formed intermediate the concave sidewalls. The second part has spaced concave sidewalls each with a pair of depending legs formed on opposite end walls which when mated with the first connector part defines two tortuous paths through the connector parts which ensure that the elastic cord lengths that are placed therethrough [are] in a stretched position [and] remain in such position without slippage.” (Abstract).

Applicant notes once again that Merritt does not disclose securing body tissue within a body, as recited in claims 1, 71, and 77. Even though Egan does relate to a suture guide and fastener, there is no motivation, other than impermissible hindsight, to combine Egan and Merritt. Even if combined as suggested in the Office Action, the invention as claimed would still not result.

In Merritt, *a combination of both a tortuous path, and a stretched elastic cord*, reduce slippage of the cord. Merritt does not suggest or teach securing an object by pressing the object *as energy is applied to separate sections*, as is claimed in the instant invention. With Merritt, the male and female bodies are releasably engaged so that “if desired the bodies may be disengaged and separated to release the cord.” The releasable engagement is a snap fit. Merritt does generally state that the “snap lock arrangement to join the components [is preferred], other attachment means may be employed, such as an adhesive or ultrasonic welding. Applicant respectfully states that this generic statement applies to other components of the lock, but does not apply to the male and female bodies since these must be releasably engaged so that the cord can be released in event of the failure of the lock mechanism.

Thus, even if Egan and Merritt were combined as suggested, the invention as set forth in claims 1, 71, and 77 would still not be obtained since any structure in either Egan or Merritt that

can even arguably be considered to read on the claimed extension does not shorten in length when the first and second sections are bonded together or shorten in the direction of force applying pressure to the fastener.

Other Secondary References

Hart, Tokushige, Bartlett, and Rhee are cited for disclosing a biodegradable material, a heat shrinkable material, viable cells, and a pharmaceutical agent, respectively. Hart pushes one fastener part inside another, to bend and trap a suture filament. The remaining references are not directly related to fasteners. Hart does not address the deficiencies of Egan and Merritt as Hart does not suggest or teach securing an object as first and second fastener portions are bonded together, as recited in claims 1 and 71, or by pressing an object between two fastener portions as the portions are being ultrasonically bonded, as recited in claim 77.

Accordingly, Applicant respectfully submits that claims 1, 71, and 77 are patentable over a combination of Egan, Merritt, Hart, Tokushige, Bartlett, and Rhee. As claims 6, 8, 20-23, 50-52, 55-57, 61, and 74 depend from claim 1, these dependent claims necessarily include all the elements of their base claim. Accordingly, Applicant respectfully submits that the dependent claims are allowable over the cited references for at least the same reasons.

In light of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the §103 rejections.

Conclusion

In light of the foregoing remarks, this application is now in condition for allowance and early passage of this case to issue is respectfully requested. If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

A fee for an extension of time is believed to be due and is being paid by credit card.
However, please charge any other required fee (or credit overpayments) to the Deposit Account
of the undersigned, Account No. 500601 (Docket No. 782-A03-023)

Respectfully submitted,

/ Paul D. Bianco /

Paul D. Bianco, Reg. 43,500

Customer Number: 33771
FLEIT GIBBONS GUTMAN BONGINI & BIANCO
21355 East Dixie Highway, Suite 115
Miami, Florida 33180
305-830-2600, fax 305-830-2605, pbianco@fggbb.com